

Remarks

Claims 1-33, 35, 39, and 40 have been cancelled without prejudice to the filing of continuing applications. In particular, claim 40 has been cancelled consistent with Applicants election of the claims of Group I. No new matter has been added by any of the amendments made herein. The amendments to the claims are fully supported by the specification as originally filed.

Claim 34 has been amended to clarify that a mixture comprising the polyester polyol is formed in (1) and the polyester polyol is subsequently alkoxyated in (2). Claims 36 and 38 have been amended to overcome the rejections of those claims based on the second paragraph of 35 U.S.C. § 112.

Claim 34 fully satisfies the second paragraph of §112. The quantities of the phthalic anhydride or acid component (a) and the polyol component (b) define the ranges of those components used to form the mixture that yields the intermediate polyester polyol. The amounts specified for those components are not their respective quantities in the final polyester-ether product generated during part (2). As a result, the amount of the alkoxyating agent should not be added to the amounts of components (a) and (b) to determine whether the specified ranges are appropriate. The sum of the amounts of (a) and (b) should be 100 percent and is 100 percent. Further, the claim makes

clear that the amount of alkoxylating agent is based on the weight of the final polyester-ether polyol product. Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejection.

The claims stand rejected under the doctrine of obviousness-type double patenting in view of Application Serial No. 09/427,050 ("the '050 application"). Applicants note that the '050 application has matured into U.S. Patent No. 6,569,352 ("the '352 patent"). Applicants respectfully submit that the claims as amended herein are patentable in view of the '352 patent. The claims in the '352 patent do not recite or suggest the use of the catalysts required by the instant claims. Applicants request the Examiner to withdraw the double patenting rejection.

Claim 34 stands rejected as being anticipated by U.S. Patent No. 5,750,580 (Mayer et al.). Applicants respectfully submit that the claims as amended are not anticipated by the compounds disclosed in the reference. Specifically, Mayer et al. does not disclose a process employing a double metal cyanide catalyst. Reconsideration and withdrawal of 35 U.S.C. §102 rejection is respectfully requested.

Claims 32-39 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Mayer et al. in combination with U.S. Patent No. 5,670,601 (Allen et al.). Applicants respectfully

disagree. The use of a double metal cyanide catalyst in the alkoxylation of polyester polyols is not obvious from Mayer et al. alone or in combination with Allen et al.

The Examiner correctly characterizes Mayer et al. as describing ethoxylation of a polyester polyol derived from a glycol and phthalic anhydride. The Examiner points to Allen et al. to support the notion that double metal cyanide catalysts were known to be preferred to catalysts such as potassium hydroxide for alkoxyating polyols in general. Applicants disagree; it was not known at the time the invention was made that double metal cyanide catalysts were preferable for ethoxylation of polyester polyols. The Examiner's reliance on Allen et al. for this notion is incorrect. The use of such catalysts to produce certain products was known. However, the teachings of art represented by Allen et al. cannot be generalized to apply to the alkoxylation of polyester polyols.

Allen et al. teaches the use of specific polyether polyols to gain physical property enhancements in elastomers. All the discussion in Allen et al. pertaining to double metal cyanide catalysts is only in the context of preparing specific polyether polyols. See Allen et al. at column 3, lines 23-34, column 12, lines 6-25, and column 12, line 47 to column 13, line 5. Importantly, Allen et al. points out in column 3 that "significant improvement in monol [sic] content of

polyoxypropylene polyols has been achieved using double metal cyanide catalysts" without making any mention of polyester polyols or using the general term polyol, which later term might suggest that such catalysts can be used in the preparation of polyols other than polyether polyols. The teachings of the Allen reference are narrowly confined to polyether polyols; its teachings cannot properly be extended to alkoxylation of polyester polyols. Accordingly, there is nothing in Allen et al. to suggest the use of double metal cyanide catalysts in the alkoxylation of polyester polyols. The claims are therefore not obvious in view of Mayer et al., taken alone or in combination with Allen et al.

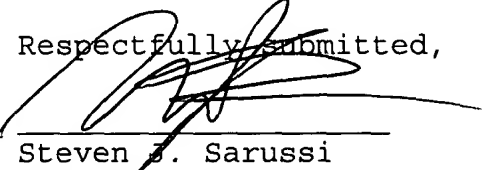
Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection are respectfully requested.

Allowance of the claims and passage of the case to issue are respectfully solicited. Should the Examiner believe a discussion of this matter would be helpful, he is invited to telephone the undersigned at (312) 913-0001.

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By:

Respectfully submitted,


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